



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

54

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/652,734	08/31/2000	Edward F. Bachner III	MBHBOO-399	3628

20306 7590 04/11/2003

MCDONNELL BOEHNEN HULBERT & BERGHOFF
300 SOUTH WACKER DRIVE
SUITE 3200
CHICAGO, IL 60606

EXAMINER

FERGUSON, KEITH

ART UNIT PAPER NUMBER

2683

DATE MAILED: 04/11/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/652,734

Applicant(s)

BACHNER ET AL.

Examiner

Keith T. Ferguson

Art Unit

2683

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 31 August 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-80 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-27 and 29-78 is/are rejected.
- 7) ☒ Claim(s) 8,28,79 and 80 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) Z.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 2683

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1-5, 9-15, 18, 33, 34, 37-43, 46-60, 63-66, 68, 70, 71 and 74-78 are rejected under 35 U.S.C. 102(e) as being anticipated by Criss et al..

Art Unit: 2683

Regarding claims 1,4,33,56,59 and 70, Criss et al. discloses a wireless intelligent personal server (mobile terminal) (wireless display system) (fig. 2), comprising: a radio frequency (Rf) receiver for receiving downstream data transmitted over a first wireless communications channel (paragraph 0056); a memory (fig. 1 number 50); a central processing unit (CPU) (fig. 1 number 40); a set of embedded machine language instructions, said set of embedded machine language instructions being executable by said CPU for processing said downstream data to provide at least one electronic file in said memory (paragraphs 0075,0076 and 0082); and a first interface (in communication with) for allowing an external display (access read only) device to access said at least one electronic file to a user (paragraph 0094).

Regarding claims 2,34,57,58 and 71, Criss et al. discloses said downstream data reflects changes made to at least one source electronic file (files do not match or new) (paragraph 0075), said at least one is electronic file being an updated version of at least one existing electronic file stored in said memory (paragraph 0075).

Regarding claim 3, Criss et al. discloses wherein said at least one electronic file is a new electronic file (paragraph 0075 and 0076).

Regarding claims 5 and 60, Criss et al. discloses said first interface (fig. 2 number 42) (keypad) allows said external display device to change said at least one electronic file (paragraph 0094).

Regarding claims 9,37,47,52,54 and 63, Criss et al. discloses a radio frequency (RF) transmitter for transmitting at least one signal over a second wireless communications channel (paragraph 0057).

Regarding claims 10,38,48,53,55,64 and 74, Criss et al. discloses said RF transmitter transmits an acknowledgement signal over said second wireless communications channel when said RF receiver receives said downstream data (paragraph 0072 and 0073).

Art Unit: 2683

Regarding claims 11,39,65 and 75, Criss et al. discloses said RF transmitter transmits upstream data over said second wireless communications channel, said upstream data reflecting changes to said at least one electronic file made by said external display device (paragraph 0094 and 0095).

Regarding claims 12 and 40, Criss et al. discloses a second interface (keypad or touch sensitive screen) for controlling a wireless telephone to transmit at least one signal (paragraph 0053).

Regarding claims 13,41 and 77, Criss et al. discloses said second interface controls said wireless telephone to transmit an acknowledgement signal when said RF receiver receives said downstream data (paragraphs 0053 and 0072).

Regarding claims 14,42,49,50 and 78, Criss et al. discloses said second interface controls said wireless telephone to transmit upstream data, said upstream data reflecting changes to said at least one electronic file made by said external display device (paragraph 0094 and 0095).

Regarding claims 15,43 and 76, Criss et al. discloses a battery for powering said wireless intelligent personal server (fig. 17 number 505).

Regarding claims 18 and 66, Criss et al. discloses a bar-code input for connecting a bar-code reader (fig 2 number 44).

Regarding claims 20 and 68, Criss et al. discloses a keyboard input for connecting an external keyboard (paragraph 0053).

Regarding claims 46 and 51, Criss et al. discloses a method for updating a target electronic file to reflect changes made to a source electronic file (paragraph 0015), comprising a wireless intelligent personal server (mobile terminal) (wireless display system) (fig. 2), comprising: a radio frequency (Rf) receiver for receiving downstream data transmitted over a first wireless

Art Unit: 2683

communications channel (paragraph 0056); a memory (fig. 1 number 50); a central processing unit (CPU) (fig. 1 number 40); a set of embedded machine language instructions, said set of embedded machine language instructions being executable by said CPU for processing said downstream data to provide at least one electronic file in said memory (paragraphs 0075, 0076 and 0082); and a first interface (in communication with) for allowing an external display device to access said at least one electronic file to a user (paragraph 0094).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 6, 7, 35, 36, 61, 62, 72 and 73 are rejected under 35 U.S.C. 103(a) as being unpatentable over Criss et al. in view of Grew et al..

Regarding claims 6, 7, 35, 36, 61, 62, 72 and 73, Criss et al. discloses a wireless intelligent personal Server as discussed supra in claims 1, 33, 56 and 70 above. Criss et al. differs from claims 6, 7, 35, 36, 61, 62, 72 and 73 of the present invention in that it do not disclose said external display device is a

Art Unit: 2683

personal digital assistant (PDA). Grew et al. teaches said external display device is a personal digital assistant (PDA) (fig. 2 and col. 1 lines 55-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Criss et al. with said external display device is a personal digital assistant (PDA) in order to have a small personal computer that an user could view download updated software file sent from the host computer, as taught by Grew et al..

5. Claims 16 and 44 are rejected under 35 U.S.C. 103(a) as being unpatentable over Criss et al. in view of Gombrich.

Regarding claims 16 and 44, Criss et al. discloses a wireless intelligent personal Server as discussed supra in claims 1,12,15,33 and 43 above. Criss et al. differs from claims 16 and 44 of the present invention in that it do not disclose first power contacts for electrically connecting to recharger contacts disposed on said external display device; and a first power management circuit for selectively connecting said battery to said first power contacts. Gombrich teaches first power contacts for electrically connecting to recharger contacts disposed on said external display device (col. 8 line 57-col. 9 line 14); and a first power management circuit for selectively connecting said

Art Unit: 2683

battery to said first power contacts (col. 7 lines 35-40).

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Criss et al. with first power contacts for electrically connecting to recharger contacts disposed on said external display device; and a first power management circuit for selectively connecting said battery to said first power contacts in order to recharge said display when reviewing download files, as taught by Gombrich.

6. Claims 17 and 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Criss et al. in view of Shimura.

Regarding claims 17 and 45, Criss et al. discloses a wireless intelligent personal Server as discussed supra in claims 1,12,15,33 and 43 above. Criss et al. differs from claims 17 and 45 of the present invention in that it do not disclose a second power contacts for electrically connecting to recharger contacts disposed on said wireless telephone; and a second power management circuit for selectively connecting said battery to said second power contacts. Shimura teaches a power contacts for electrically connecting to recharger contacts disposed on said wireless telephone (fig. 2 numbers 31a-31c; and a power management circuit (fig. 2 number 34) for selectively connecting said battery to said power contacts (col. 2 lines 47-54).

Art Unit: 2683

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide

Criss et al. with a second power contacts for electrically connecting to recharger contacts disposed on said wireless telephone; and a second power management circuit for selectively connecting said battery to said second power contacts in order to recharge the mobile terminal when the battery is low, as taught by Shimura.

7. Claims 19,20,21,67 and 69 are rejected under 35 U.S.C.

103(a) as being unpatentable over Criss et al. in view of Ausems et al..

Regarding claims 19,20,21,67 and 69, Criss et al. discloses a wireless intelligent personal Server as discussed supra in claims 1 and 56 above. Criss et al. differs from claims 19,20,21,67 and 69 of the present invention in that it do not disclose a GPS input for connecting a global positioning system (GPS) receiver and a card reader input for connecting a card reader. Ausems et al. teaches a GPS input for connecting a global positioning system (GPS) receiver (col. 5 lines 35-46) and a card reader input for connecting a card reader (col. 3 lines 15-20 and col. 5 lines 46-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide Criss et al. with a GPS input for connecting a global positioning system (GPS) receiver and a card reader input for connecting a card reader in order to determine

Art Unit: 2683

the mobile terminal position and provide access to a wireless network by using its SIM card, as taught by Ausems et al..

8. Claims 22-25, 29 and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Criss et al. in view of Ogasawara.

Regarding claims 22-24, Criss et al. discloses a wireless intelligent personal server (mobile terminal) (fig. 2), comprising: a radio frequency (Rf) receiver for receiving downstream data transmitted over a first wireless communications channel (paragraph 0056); a memory (fig. 1 number 50); a central processing unit (CPU) (fig. 1 number 40); a set of embedded machine language instructions, said set of embedded machine language instructions being executable by said CPU for processing said downstream data to provide at least one electronic file in said memory (paragraphs 0075, 0076 and 0082); and a first interface for allowing an external display (i.e. read only access) device to access said at least one electronic file (paragraph 0094). Criss et al. differs from claim 22 of the present invention in that it do not disclose a wireless telephone in communication with said wireless intelligent personal server, said wireless telephone transmitting an acknowledgment signal over a second wireless communications channel when said wireless intelligent personal server receives said downstream data. Ogasawara teaches a wireless telephone (fig. 1 number 18) in communication with said wireless intelligent personal server (fig. 1 number 10 and 11), said wireless telephone transmitting an acknowledgment signal over a second wireless communications channel when said wireless intelligent personal server receives said downstream data (col. 6 lines 12-16). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made To provide Criss et al. with a wireless telephone in communication with said wireless intelligent personal server, said wireless telephone transmitting an acknowledgment signal over a second wireless communications channel when said wireless intelligent personal server receives said downstream data in order for a wireless telephone to receive files to perform electric shopping while exchanging bar code signals of can goods, as taught by Ogasawara.

Art Unit: 2683

Regarding claim 25, Criss et al. discloses said first interface (fig. 2 number 42) (keypad) allows said external display device to change said at least one electronic file (paragraph 0094).

Regarding claim 29, Criss et al. discloses said mobile terminal transmits upstream data over said second wireless communications channel, said upstream data reflecting changes to said at least one electronic file made by said external display device (paragraph 0094 and 0095).

Regarding claim 30, Criss et al. discloses a battery for powering said wireless intelligent personal server (fig. 17 number 505).

9. Claims 26 and 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Criss et al. in view of Ogasawara as applied to claims 22 and 23 above and in further view of Grew et al..

The combination of Criss et al. and Ogasawara differs from claims 26 and 27 of the claimed invention in that they do not disclose said external display device is a personal digital assistant (PDA). Grew et al. teaches said external display device is a personal digital assistant (PDA) (fig. 2 and col. 1 lines 55-64). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the combination of Criss et al. and Ogasawara with said external display device is a personal digital assistant (PDA) in order to have a small personal computer that an user could view download updated software file sent from the host computer, as taught by Grew et al..

10. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Criss et al. in view of Ogasawara as applied to claims 22 and 30 above and in further view of Shimura.

The combination of Criss et al. and Ogasawara differs from claims 31 of the claimed invention in that they do not disclose a first power contacts electrically connected to recharger contacts disposed on said wireless telephone; and a first power management circuit for selectively connecting said battery to said first power contacts. Shimura teaches a power contacts for electrically connecting to recharger contacts disposed on said wireless telephone (fig. 2 numbers 31a-31c; and a power management circuit (fig. 2 number 34) for selectively connecting

Art Unit: 2683

said battery to said power contacts (col. 2 lines 47-54). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the combination of Criss et al. and Ogasawara with a second power contacts for electrically connecting to recharger contacts disposed on said wireless telephone; and a second power management circuit for selectively connecting said battery to said second power contacts in order to recharge the mobile terminal when the battery is low, as taught by Shimura.

11. Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over Criss et al. in view of Ogasawara as applied to claims 22 and 30 above and in further view of Gombrich.

The combination of Criss et al. and Ogasawara differs from claim 32 of the claimed invention in that they do not disclose a second power contacts electrically connected to recharger contacts disposed on said external display device; and a second power management circuit for selectively connecting said battery to said first power contacts. Gombrich teaches first power contacts for electrically connecting to recharger contacts disposed on said external display device (col. 8 line 57-col. 9 line 14); and a first power management circuit for selectively connecting said battery to said first power contacts (col. 7 lines 35-40). Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the combination of Criss et al. and Ogasawara with first power contacts for electrically connecting to recharger contacts disposed on said external display device; and a first power management circuit for selectively connecting said battery to said first power contacts in order to recharge said display when reviewing download files, as taught by Gombrich.

Allowable Subject Matter

12. Claims 8,28,79 and 80 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.


Art Unit: 2683

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Keith T. Ferguson whose telephone number is (703) 305-4888. The examiner can normally be reached on 6:30am-5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703) 308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9314 for regular communications and (703) 872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 306-0377.

Keith Ferguson *KF*
Art Unit 2683
April 3, 2003


WILLIAM TROST
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2600